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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,402	03/11/2004	Andrew Candelora	603162-999030CIP	7162
20583	7590	03/30/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			WALCZAK, DAVID J	
			ART UNIT	PAPER NUMBER
			3751	
DATE MAILED: 03/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/800,402	CANDELORA ET AL.	
	Examiner	Art Unit	
	David J. Walczak	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 9-16, 22-25 and 31-33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-30 and 34-36 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-8 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 3 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/24/04 & 7/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election

Applicant's election without traverse of Group I, Species I in the reply filed on 2/7/06 is acknowledged. After further consideration, Species IV (Figures 11 and 12) will be joined with Species I since Figures 11 and 12 merely add a stop element to the same end plug defined in Species I. Claims 1-8, 17-21 and 26-36 are in Group I, however, claims 31-33 are directed to non-elected Species II and, accordingly, will not be examined herein. Claims 1-8, 17-21, 26-30 and 34-36 are readable on elected Species I and will be examined herein. Claims 9-16, 22-25 and 31-33 are hereby withdrawn from consideration.

Drawings

The drawings are objected to because reference character 504 (page 11, line 9) is not present in any of the drawings.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the threaded attachment (claim 3) must be shown or the feature canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

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number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: Paragraph 001 should be updated to indicate that application 10/389,300 is now abandon. Further, on page 6, line 31, "17" should be --32--, on page 7, line 2, "134" should be --136-- and on page 11, line 11, "52" should be --50--. Lastly, reference character 520 is used to denote two different elements (see page 12, line 10 and page 13, line 10; it is noted that the drawings indicate that reference character 520 is directed to the closed end of the channel, as disclosed on page 12, and not "flats", as disclosed on page 13). Appropriate correction is required.

Claim Objections

Claim 28 is objected to because of the following informalities: It appears that the verbiage on lines 9-11 after "position." should be deleted since this language has already been recited on lines 7-9. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 5, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In regard to claim 5, the specification has not enabled an end plug that is both adjustable via a threaded attachment (claim 3, from which claim 5 depends) and ultrasonically welded to the barrel. In regard to claims 18 and 19, the specification has not disclosed a cushioning element that is formed integrally with the barrel or integrally with a front nose cone.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. An antecedent basis for "at least one of said cushioning elements (line 4) should be defined (currently, only "a cushioning element" has been defined).

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6-8, 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kageyama '533 (hereinafter Kageyama, as cited by the Applicant). In regard to claim 1, Kageyama discloses a writing instrument comprised of a barrel 11 having a proximal end with a proximal opening and a distal end with a writing end opening disposed opposite the proximal end, a writing medium cartridge 16, 17 positioned in the barrel and having a writing tip 114 extending out of the writing tip opening and a proximal end, an end plug 19 in the proximal opening and a cushioning element 112 formed integrally as a single piece with the end plug wherein the cushioning element abuts with the proximal end of the cartridge portion 17. In regard to claims 2 and 4, the end plug 19 is "permanently" attached to the barrel. In regard to claim 6, the cushioning element is spring-shaped. In regard to claim 7, the cushioning element "holds" the cartridge. In regard to claim 8, the cushioning element includes a hole therein which is capable of allowing venting. In regard to claim 17, Kageyama discloses a writing instrument comprised of a plurality of components 11, 19 and a cushioning element 112 integrally formed with component 19 and a writing element 14, 16, 17, 114 "held" by the cushioning element. In regard to claim 20, Kageyama discloses a writing instrument comprised of a barrel 11, a cartridge 14, 16, 17 in the

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barrel and having a writing tip 14 extending therefrom, an end plug 19 and a cushioning element 112 formed integrally with the plug wherein the cartridge (portion 14 thereof) is "held" by the cushioning element.

Allowable Subject Matter

Claims 3 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 26-30 and 34-36 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
3/28/06